

REMARKS

Applicant respectfully requests consideration of the subject application. This Response is submitted in response to the Office Action mailed April 23, 2007. Claims 1, 6, 7, 10-12, 17, 18 and 21-52 are pending. Claims 1, 6, 7, 10-12, 17, 18, 21 and 22 are rejected. In this Amendment, claims 1, 10, 12 and 21 have been amended, and claims 23-52 have been added. No new matter has been added.

35 U.S.C. §112, First Paragraph Rejections

The Examiner has rejected claims 1 and 12 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner asserts that the phrase “wherein the at least two operation functions of the at least two control devices are independent of the information displayed in the digital display” is not supported by the specification. Claims 1 and 12 have been amended. Applicants, accordingly, respectfully request withdrawal of the rejections under 35 U.S.C. § 112, first paragraph.

35 U.S.C. §102 Rejections

The Examiner has rejected claims 1, 6, 7, 10-12, 17, 18, 21 and 22 under 35 U.S.C. § 102(b) as being anticipated by Want, et al. (U.S. Patent No. 5,825,675, hereinafter “Want”).

In Want, computer 100 includes buttons 384, 386 and 388 control the scrolling and selection of information in display screen 380. As explained at col. 7, lines 21-43 and shown in Figs. 4A and 4B, buttons 384, 386 and 388 are given functions of "UP," "SELECT," and "DOWN." For the left held configuration in Fig. 4A, button 384 provides the "UP" function, button 386 provides the "SELECT" function and button 388 provides the "DOWN" function. For the right held configuration in Fig. 4B, button 384 provides the "DOWN" function, button 386 provides the "SELECT" function and button 388 provides the "UP" function. Thus, buttons 384 and 388 toggle between the "UP" and "DOWN" functions depending on whether the left held or right held configuration is used, and button 386 provides the "SELECT" function in the left held and right held configurations.

A user can scroll through the menu to control various operating functions of the portable device, listed as "Power down," "Left/Right mode," "Agent ESC," "Battery check," "Local Applications" and "Quit local mode."

Thus, buttons 384, 386 and 388 do not control track skip or volume. Likewise, the operating functions that are controlled by buttons 384, 386 and 388 do not include track skip or volume.

Claim 1 recites "A portable digital device comprising: at least two control devices for controlling at least two operating functions of the portable digital

device . . . wherein the at least two operating functions are selected from the group consisting of: track skip forward, track skip back, increase volume, and decrease volume.” Claim 12 recites similar limitations.

Want fails to disclose all of the limitations of independent claims 1 and 12. In Want, buttons 384, 386 and 388 do not control forward or back track skip, or increase or decrease volume functions of computer 100. Moreover, Want says nothing about skipping, tracks or any other playback parameter of computer 100. Likewise, Want says nothing about volume, loudness or any other audio parameter of computer 100.

The Examiner asserts that “Want teaches . . . the at least two operating functions are selected from the group consisting of: skip forward, skip back, increase volume, and decrease volume.” However, the Examiner fails to cite any teaching in Want that supports this assertion.

The Examiner apparently bootstraps the assertion in the Office Action dated January 5, 2007 that “track selection is clearly illustrated in figs. 4.” However, the scrolling through the menu items in the TAB Local Menu on display screen 380 would not be considered forward and back track skip in a portable digital device by those skilled in the art. Rather, a track in a portable digital device is a separate piece of music or song, as is clear to those skilled in the art.

Thus, the Examiner has interpreted forward and back track skip in a portable digital device in an unreasonably broad and unsupported manner. That is, the Examiner has interpreted forward and back track skip to encompass scrolling through any menu item, regardless of the nature of the menu items. Moreover, the Examiner has failed to provide any support, either in *Want* or elsewhere, that forward and back track skip in a portable digital device encompasses scrolling up and down through the menu items in Figs. 4A and 4B that have nothing to do with songs, music or any other audio, video or recorded media content.

For anticipation under 35 U.S.C. § 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir.1989). This is also illustrated in *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) wherein "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Want fails to disclose, teach or suggest all of the limitations of independent claims 1 and 12. As claims 6-7, 10-11, 17-18 and 21-22 depend, directly or indirectly from independent claims 1 and 12, claims 6, 7, 10, 11, 17, 18,

21 and 22 are also patentable over Want for at least the same reasons.

Applicants, accordingly, respectfully request withdrawal of the rejections under 35 U.S.C. § 102.

New Claims

Claim 23 recites "A portable digital device comprising: control devices for controlling operating functions of the portable digital device in response to manual actuation by a user, wherein the control devices include a first button and a second button . . . the first button increases volume of the portable digital device and the second button decreases volume of the portable digital device in the right-hand orientation, and the first button decreases volume of the portable digital device and the second button increases volume of the portable digital device in the left-hand orientation."

Want fails to teach or suggest that buttons 384, 386 or 388 increase or decrease the volume of computer 100, as mentioned above.

As claims 24-32 depend, directly or indirectly from independent claim 23, claims 24-32 are also patentable over Want for at least the same reasons.

Claim 33 recites "A portable digital device comprising: control devices for controlling operating functions of the portable digital device in response to manual actuation by a user, wherein the control devices the control devices

include a button and a rotatable knob . . . and the knob provides a third operating function for the portable digital device in the right-hand and left-hand orientations and reverses orientation of the third operating function between the right-hand and left-hand orientations such that the knob provides the third operating function for the user in the right-hand and left-hand orientations.”

Want fails to teach or suggest that buttons 384, 386 or 388 are rotatable knobs. Instead, buttons 384, 386 and 388 are push buttons that slide in-and-out along a single direction substantially parallel to a line drawn from the first and second knuckles of the user’s finger that depresses the button. For instance, button 384 slides in-and-out along direction B—B' as shown in Figs. 3C and 3D.

As claims 34-42 depend, directly or indirectly from independent claim 33, claims 34-42 are also patentable over Want for at least the same reasons.

Claim 43 recites “A portable digital device comprising: control devices for controlling operating functions of the portable digital device in response to manual actuation by a user, wherein the control devices include a first button and a second button . . . the portable digital device is adapted to be gripped by and substantially fit within and operated by a right hand of the user for the right-hand use, the portable digital device is adapted to be gripped by and substantially fit within and operated by a left hand of the user for the left-hand use, the portable digital device is adapted for the control devices to be actuated

by a single finger within the right hand of the user for the right-hand use, and the portable digital device is adapted for the control devices to be actuated by a single finger within the left hand of the user for the left-hand use.”

Support for the portable digital device being adapted to be gripped by and substantially fit within and operated by a right hand of the user for right-hand use, with the control devices actuated by a single finger within the right hand, is provided by Fig. 3.

Support for the portable digital device being adapted to be gripped by and substantially fit within and operated by a left hand of the user for left-hand use, with the control devices actuated by a single finger within the left hand, is provided by Fig. 4.

Want fails to teach or suggest that buttons 384, 386 or 388 are actuated by a single finger. Instead, buttons 384, 386 and 388 are depressed by the user's index finger, middle finger and ring finger. For instance, buttons 314, 316 and 318 are depressed by the user's left index finger 308, left middle finger 310 and left ring finger 312, respectively in the left held configuration in Fig. 3A, and buttons 314, 316 and 318 are depressed by the user's right ring finger 358, right middle finger 356 and right index finger 354, respectively in the right held configuration in Fig. 3C.

As claims 44-52 depend, directly or indirectly from independent claim 43, claims 44-52 are also patentable over Want for at least the same reasons.

Specification

A substitute specification has been provided to comply with 37 CFR § 1.52(a) and (b). The Substitute Specification is provided to improve clarity of the originally filed Specification. No new matter has been added.

Drawings

The Drawings have been amended at Fig. 5 to improve clarity. No new matter has been added. An Appendix with amended drawing figures is attached hereto. The Appendix includes a Replacement Sheet and an Annotated Sheet Showing Changes for each amended figure. In Fig. 5, O/S 26 has been changed to processor 26, and O/S 27 has been shown as a separate block within processor 26, as set forth in the Substitute Specification at page 3, lines 33-37, and page 4, lines 8-20 and 26-35.

Applicants respectfully submit that the present application is in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call Jennifer Hayes at (408) 720-8300.

Please charge the fees for additional claims, the one month extension of time and any shortages and credit any overages to Deposit Account No. 02-2666. Any necessary extension of time for response not already requested is hereby requested. Please charge any corresponding fee to Deposit Account No. 02-2666.

Respectfully submitted,
Blakely, Sokoloff, Taylor & Zafman LLP

ORIGINAL SIGNED BY

Jennifer Hayes -aeb

Date: August 23, 2007

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APPENDIX

Annotated Sheet Showing Changes

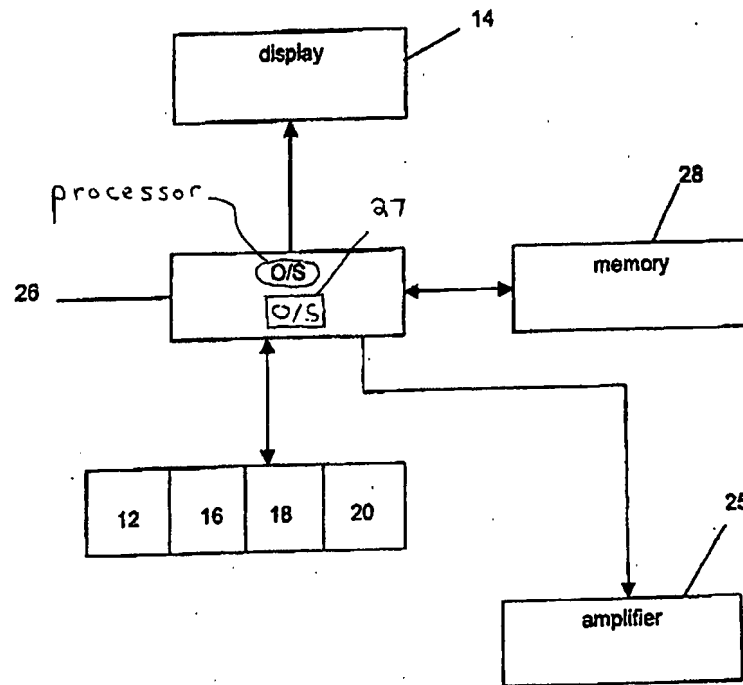


Figure 5